

1 **REMARKS**

2 Brief History of the Present Application:

3 The present application is a divisional application of U.S. Patent Application
4 Serial No. 09/992,245, filed November 14, 2001. In an Office action dated February
5 21, 2003, a restriction requirement was imposed, in which the Examiner identified
6 three separate species corresponding to: (Species I) claims 1-5 and 15-19; (Species
7 II) claims 6-14; and (Species III) claims 20-25.

8 Species I (claims 1-5 and 15-19) is directed to a sheet finishing apparatus and
9 a method of folding a sheet of media, while species II (claims 6-14) is directed to a
10 document processing apparatus, and species III (claims 20-25) is directed to a sheet
11 finishing apparatus configured to be used in conjunction with a sheet
12 imaging apparatus.

13 A preliminary amendment was filed with the present application, in which
14 species II was elected for prosecution and claims 1-5 and 15-25 were cancelled.

15 In the initial Office action, all of the claims were rejected under 35 U.S.C.
16 102(b) and/or under 35 U.S.C. 103(a).

17 In a response to the initial Office action in which all of the claims were
18 rejected, the Applicant amended the claims as follows in an effort to put the
19 application in condition for allowance. Claims 6 and 7 were cancelled and claims 8
20 and 10, which each previously depended from claim 7, were amended to each be in
21 independent form and to include elements and/or limitations of claims 6 and 7.
22 Claim 12, which each previously depended from claim 6, was amended to be in
23 independent form and to include elements and/or limitations of claim 6. Claim 11,
24 which previously depended from claim 6, was amended to depend from claim 8.
25 Claim 14, which previously depended from claim 6, was amended to be in
independent form and to include elements and/or limitations of claims 6 and 7.
Additionally, new claims 26-37 were added.

24 Traverse of Restriction and Request for Reconsideration:

25 In the current Office action, the Examiner contends that newly submitted
claims 10, 12-14, and 26-37 are directed to inventions that are independent or
distinct from the invention originally claimed.

1 In accordance with MPEP 803, there are two criteria for a proper requirement
2 for a restriction between patentably distinct inventions: (A) the inventions must be
3 independent or distinct as claimed; and, (B) there must be a serious burden on
4 the Examiner.

5 With respect to claims 10, 12-14, 26-32, and 37, the Applicant traverses the
6 restriction requirement on the basis that there is no serious burden on the Examiner
7 because each of those claims is substantially no different than one or more of the
8 originally-elected claims. In an attempt to comply with the requirements of 37 CFR
9 1.143, the Applicant provisionally elects species II, and concurs with the constructive
10 election of the originally presented invention as explained by the Examiner in the
11 current Office action.

12 In regard to claim 10, the Examiner contends that "the new invention of claim
13 10 requires first and second knives supported by first and second rollers (without a
14 cutting/creasing anvil)."

15 However, the Applicant contends that claim 10, as originally elected, required
16 essentially the same elements and/or limitations – *i.e.*, first and second knives
17 supported by first and second rollers (without a cutting/creasing anvil).

18 That is, the current version of claim 10 contains substantially the same
19 elements and/or limitations as is contained in claim 10 as originally presented for
20 prosecution of the elected species. Stated in another way, the only substantial
21 difference between the current version of claim 10 and the originally elected version
22 of claim 10 is that the current version of claim 10 is in independent form.

23 In regard to claims 12, 13, and 14, those claims likewise contain substantially
24 the same elements and/or limitations that were contained in the originally-elected
25 versions of the claims. In regard to claims 26-32 and 37, those claims contain
substantially the same elements and/or limitations as are contained in one or more of
the originally-elected claims, although different language and/or terminology is used
in claims 26-32 and 37.

Accordingly, the Applicant contends that there is no serious burden on the
Examiner in examining claims 10, 12-14, 26-32, and 37 because all those claims are
directed to the originally-elected species.

Furthermore, the Applicant contends that there can be no reasonable
conclusion that claims 10, 12-14, 26-32, and 37 are directed to inventions that are

1 independent or distinct from the invention originally claimed, because claims 10, 12-
2 14, 26-32, and 37 contain, in various forms, substantially the same elements and/or
3 limitations as are contained in one or more of the originally-elected claims.

4 In regard to claims 33-36, the Applicant concedes that those claims may be
5 directed to inventions that are independent or distinct from the invention originally
6 claimed. Accordingly, the Applicant has withdrawn claims 33-36.

7 In view of the above reasons, the Applicant requests reconsideration and/or
8 modification of the restriction requirement, wherein at most only claims 33-36 are
9 subject to restriction.

10 Request for Withdrawal of Final Rejection as Premature:

11 The Applicant notes that "second or any subsequent actions on the merits
12 shall be final, except where the examiner introduces a new ground of rejection that is
13 neither necessitated by applicant's amendment of the claims nor based on
14 information submitted in an information disclosure statement" (MPEP 706.07(a).)
15 That is, a second or subsequent action cannot be made final if the Examiner
16 introduces a new ground of rejection that is not necessitated by the Applicant's
17 amendment of the claims nor by information submitted in an information
18 disclosure statement.

19 The Applicant notes that in the previous Office action, claims 8, 9, and 11
20 were rejected under 35 U.S.C. 102(b) only. In the current Office action, claims 8, 9,
21 and 11 are rejected under 35 U.S.C. 103(a). Thus, the Examiner has introduced a
22 new ground of rejection. This new ground of rejection is not necessitated by
23 information submitted in an information disclosure statement. Furthermore, this new
24 ground of rejection is not necessitated by the Applicant's amendments of the claims
25 because the amendments of claims 8, 9, and 11 consist substantially of rewriting
claim 8 in independent form, and changing the dependency of claim 11 from claim 6
to claim 8. That is, no new elements and/or limitations were added by way of
amendment with respect to claims 8, 9, and 11. Therefore, the Examiner's new
ground of rejection was not necessitated by the Applicant's amendments of
the claims because the amendments were not substantive.

Accordingly, in view of the above reasons, the Applicant requests withdrawal
of the final rejection as premature.

1 Rejection of Claims Under 35 U.S.C. § 103:

2 Claim 8 has been rejected under 35 U.S.C. 103(a) as being unpatentable over
3 Couturier (US 6,296,601), and claims 8, 9 and 11 have been rejected under 35
4 U.S.C. 103(a) as being unpatentable over Boronka et al. (US 5,417,642) in view
5 of Couturier.

6 The rejection of claims 8, 9, and 11 is based, among other things, on the
7 Examiner's contention that Couturier teaches retractable cutting anvils.

8 However, claims 8, 9, and 11 do not require, nor contain, the element and/or
9 limitation of "retractable cutting anvil." Rather, claims 8, 9, and 11 require, among
10 others, the following elements and/or limitations:

11 a cutting anvil disposed within the second roller and operably moveable from
a first position in which the cutting anvil is withdrawn from the slot to a second
position in which the anvil is exposed within the slot.

12 In accordance with the generally accepted standard for an obviousness
13 rejection, a claim is obvious only if, among other things, all of the claim limitations
14 are taught or suggested by the prior art. (MPEP 2143.03.) That is, "when evaluating
15 claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be
16 considered and given weight" (Id.)

17 The Applicant contends that the prior art, including Couturier, does not teach
18 or suggest all of the claim limitations required by claim 8, 9, and 11 as explained
19 above. That is, the element "retractable cutting anvil", as disclosed by Couturier, is
20 not equivalent to the element "a cutting anvil disposed within the second roller and
operably moveable from a first position in which the cutting anvil is withdrawn from
the slot to a second position in which the anvil is exposed within the slot" as is
21 recited in claim 8.

22 Furthermore, with respect to claim 9, that claim requires the following
23 elements and/or limitations:

24 a creasing anvil disposed within the second roller and operably moveable
from a first position in which the creasing anvil is withdrawn from the elongated slot
to a second position in which the creasing anvil is exposed within the elongated slot.

25 The Applicant contends that the prior art does not teach or suggest all of
these claim limitations required by claim 9 as explained above. Moreover, the

1 Examiner makes no contention that these elements and/or limitations recited in claim
2 9 are taught or suggested by the prior art.

3 With respect to claim 11, that claim requires the following elements
4 and/or limitations:

5 wherein the first roller further comprises a cam disposed within the elongated
6 slot and in contact with the knife, the cam configured to slidably move along a portion
7 of the length of the first roller and thereby operably move the knife from the first
8 position to the second position.

9 The Applicant contends that the prior art does not teach or suggest all of
10 these claim limitations required by claim 11 as explained above. Again, the
11 Examiner makes no contention that these elements and/or limitations recited in claim
12 11 are taught or suggested by the prior art.

13 Therefore, claims 8, 9, and 11 are nonobvious in view of the prior art because
14 the prior art does not teach or suggest all of the claim limitations as required by each
15 of those claims. Accordingly, the Applicant respectfully requests that the rejections
16 of claims 8, 9, and 11 be withdrawn and that those claims be allowed.

17 SUMMARY

18 The Applicant believes that this communication constitutes a full and complete
19 response to the final Office action mailed 02/09/2005. The Applicant respectfully
20 traverses, and requests reconsideration of, the restriction requirement. Also, the
21 Applicant respectfully requests withdrawal of the finality of the final rejection.
22 Additionally, the Applicant respectfully requests withdrawal of the rejections of claims
23 8, 9 and 11, and timely allowance of claims 8-14, 26-32, and 37.

24 The Examiner is requested to contact the below-signed representative if the
25 Examiner believes this will facilitate prosecution toward allowance of the claims.

Respectfully submitted,
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Date: April 06, 2005

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